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LAW OFFICES OF RAYMOND A. NUZZO, LLC 579 THOMPSON AVENUE EAST HAVEN, CT 06512				WRIGHT, JAMES B
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/510,465	MUZAFFAR ET AL.
	Examiner	Art Unit
	J. Bradley Wright	3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-12 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-12 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 06 October 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/6/2004</u> . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because it exceeds 150 words in length. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure. In particular, the abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

2. Further, the abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(4). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

Claim Objections

3. Claims 1, 2, 5 and 6 are objected to because of the following informalities:
- Line 2 of claim 1 contains a superfluous dash. The term "comprising:-" should read "comprising:".
 - Line 3 of claim 2 contains a superfluous dash. The term "comprising:-" should read "comprising:".
 - Line 4 of claim 5 contains a superfluous dash. The term "comprising:-" should read "comprising:".

- Line 7 of claim 5 contains a typographical error. The term “the said receiver” should read “the receiver” or “said receiver”.
- Line 1 of claim 6 contains a superfluous dash. The term "(iii):-" should read "(iii):"
- Line 3 of claim 6 contains a typographical error. The term “cosequence” should read “consequence”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Regarding claims 1-5, 7-8 and 11-12,** the claims contain the following limitations:

- Claim 1 recites the limitation "the mobile telephone account" in lines 16-17.
- Claim 2 recites the limitation "the mobile telephone account" in lines 12-13.
- Claim 2 recites the limitation "the customer" in line 5.
- Claim 3 recites the limitation "the mobile telephone user" in lines 8-9.
- Claim 3 recites the limitation "the mobile telephone account" in line 11.

- Claim 4 recites the limitation "the mobile telephone account" in line 10.
- Claim 5 recites the limitation "the mobile telephone account" in lines 12-13.
- Claim 7 recites the limitation "the mobile telephone user" in lines 6-7.
- Claim 7 recites the limitation "the mobile telephone account" in line 11.
- Claim 8 recites the limitation "the mobile telephone account" in lines 9-10.
- Claim 11 recites the limitation "the combined cost" in lines 2.
- Claim 12 recites the limitation "the mobile telephone account holder" in lines 2-3.

There is insufficient antecedent basis for these limitations in the claims.

6. **Regarding claim 1**, the claim is incomplete because it omits essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. In particular, step iii refers to the mobile telephone text message receiving center being operable for responding automatically to the receipt of a coded text message. However, the step previously refers to the coded message being made available by the transmitter and the receiver, with no reference to the text message receiving center. Therefore, it is unclear as to how the coded message reaches the receiving center, specifically, whether the coded message is sent to the receiving center directly from the transmitter or from the customer apparatus by way of the mobile phone. For the purposes of examination, it is assumed that the message is forwarded to the receiving center by the mobile phone. Appropriate correction and clarification is required.

7. Additionally, regarding claim 1, the limitation in step iii wherein the transmitter and receiver are operable for making available through the receiver a coded message is unclear as to how or to whom the message is being made available. For the purposes of examination, it is assumed that the message is made available to a user of the mobile telephone. Appropriate correction and clarification is required.

8. **Regarding claim 2,** the claim at line 5 refers to "the customer" and at line 10 refers to "a customer". It is unclear as to whether the two limitations are directed to the same customer. For the purposes of examination, it is assumed that the two referenced customers are the same. Appropriate correction and clarification is required.

9. Additionally, similar to claim 1 above, claim 2 recites the limitation in step i wherein the transmitter and receiver are operable for making available at the receiver a coded message is unclear as to how or to whom the message is being made available. For the purposes of examination, it is assumed that the message is made available to a user of the mobile telephone. Appropriate correction and clarification is required.

10. **Regarding claim 4,** it is unclear as to whether the digital broadcast transmitting station or the receiving and decoding means of the text message receiving centre is operable for automatically enabling supply of the goods or services and debiting the cost thereof to the mobile telephone account (see lines 9-10). For the purposes of

examination, it is assumed that the receiving and decoding means of the receiving centre performs the functions. Appropriate correction and clarification is required.

11. **Regarding claim 5**, it is unclear as to whether the Applicant is attempting to claim a method or a system. The claim refers to a system within a method, and recites that "the system compris[es] the following steps:" (see line 4). Thus, the preamble of the claims indicates that Applicant is attempting to claim a system (i.e. an apparatus), but the claims consist only of a series of steps to be performed (i.e. a method). As such, the claims fail to positively recite any structure of the system. Appropriate correction and clarification is required.

12. In the interest of compact prosecution, if claim 5 is directed to a method, the claim, similar to claim 1 as noted above, is further incomplete because it omits essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. In particular, step ii refers to text message receiving center being operable for receiving text messages sent to it by mobile telephone and decoding a coded text message. However, step i refers to the coded text message being made available to the customer by the transmitter and the receiver, with no reference to the text message receiving center or the mobile phone. Therefore, it is unclear as to how the coded text message reaches the receiving center and to what the relation between the coded text message and the mobile phone may be. The Examiner further notes the ambiguous use of the terms "text messages" and "coded text message". For the purposes of examination, it is

assumed that the coded text message is received by the mobile phone and sent to the receiving center by the mobile phone. Appropriate correction and clarification is required.

13. Additionally, with respect to claim 5, it is unclear as to which part of the system performs the function of debiting the cost of the goods. For the purposes of examination, it is assumed that the receiving centre performs this function. Appropriate correction and clarification is required.

14. **Regarding claim 6**, in light of the unclear relationships identified above in item 11 with respect to claim 5, it is unclear as to which part of the system performs the function of sending the confirmation to the mobile phone. For the purposes of examination, it is assumed that the receiving centre performs this function. Appropriate correction and clarification is required.

15. **Regarding claim 7**, it is unclear as to whether the Applicant is attempting to claim a method or a system. The preamble of the claim refers to a system, but recites that "the system includ[es] the step of" (see line 2). Thus, the preamble of the claims indicates that Applicant is attempting to claim a system (i.e. an apparatus), but the claims consist only of a step to be performed (i.e. a method). As such, if the claim is directed to a system, the claims fail to positively recite any structure of the system. Appropriate correction and clarification is required.

16. Further, in the interest of compact prosecution, if claim 7 is directed to a method, the claim solely provides for the use of a mobile telephone text message receiving station comprising a means for performing several functions, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, *positive* steps delimiting how this use is actually practiced.

17. **Regarding claim 8**, it is unclear as to whether the Applicant is attempting to claim a method or a system. The preamble of the claim refers to a system, but recites that "the system includ[es] the step of" (see line 2). Thus, the preamble of the claims indicates that Applicant is attempting to claim a system (i.e. an apparatus), but the claims consist only of a step to be performed (i.e. a method). As such, if the claim is directed to a system, the claims fail to positively recite any structure of the system. Appropriate correction and clarification is required.

18. Further, in the interest of compact prosecution, if claim 8 is directed to a method, the claim solely provides for the use of a digital broadcast transmitting station that makes a coded text message available to a user, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant

is intending to encompass. A claim is indefinite where it merely recites a use without any active, *positive* steps delimiting how this use is actually practiced.

19. **Regarding claim 9**, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

20. **Regarding claims 9, 10 and 12**, it is unclear as to which element of the system is operable to perform the functions recited therein. Appropriate correction and clarification is required.

21. **Regarding claim 11**, in the interest of compact prosecution, if claim 8 is directed to a method, claim 11 provides for the use of premium rate text message destination, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, *positive* steps delimiting how this use is actually practiced.

22. **Regarding claim 12**, the claim includes the limitation "pay-as-you-go (pre-payment)" on line 3. It is unclear as to whether the terms are cumulative or should be viewed in the alternative. Appropriate correction and clarification is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

23. Claims 5-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 U.S.C. 101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent: processes, machines, manufactures and compositions of matter. The latter three categories define “things” or “products” while the first category defines “actions” (i.e., inventions that consist of a series of steps or acts to be performed).

As noted above, the preamble of the claims indicate that Applicant is claiming a system (i.e. an apparatus), but the claims consist only of a step or series of steps to be performed (i.e. a method). As previously discussed, the preamble of the claims includes language such as, "the system comprising the following steps:" (see e.g. claim 5, line 4). As such, the claims fail to positively recite any structure of the system. While an apparatus claim with process steps is not necessarily classified as a “hybrid” claim, rather simply an apparatus claim including functional limitations, the present claims fail to positively recite any structural limitations of the system/apparatus.

24. In the interest of compact prosecution, if claims 7 and 8 are directed to methods, then claims 7-12 are rejected under 35 U.S.C. 101 because the claimed recitation of a

use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

25. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stadelmann (US Patent No. 6,415,156) in view of Teicher (US Patent Application Publication No. 2002/0156696).

26. **Regarding claims 1-5 and 7-8**, Stadelmann discloses a payment system and method for use in conjunction with the supply of goods and services (see Figure 1 and Abstract) including:

- Supplier apparatus including a transmitter for broadcasting digital signals and a mobile telephone text message receiving centre coupled to the transmitter (column 2, lines 20-48).

- Customer apparatus including a digital signal receiver for receiving the broadcast digital signals from the transmitter and a mobile telephone for sending text messages to the text message receiving centre (column 2, lines 4-10).

- The transmitter and said receiver being operable for making available a customer through the receiver a coded message denoting goods or services to be supplied and identifying the receiver (column 3, lines 12-20).

- The mobile telephone text message receiving center being operable for responding automatically to the receipt of said coded text message sent by the customer via the mobile telephone, decoding the message, initiating the supply of said goods or services, and debiting the cost of the goods or services to the mobile telephone account (column 3, lines 21-40 and 47-48; column 3, line 64 - column 4, line 5; and column 4, lines 20-29) .

However, Stadelmann does not explicitly disclose that the account to be debited is a mobile telephone account. Teicher, in an analogous art, teaches a system and method for micropayment in electronic commerce (see Abstract) teaches that it was old and well-known in the art at the time the invention was made that goods and services sold via electronic and mobile commerce may be billed to the customer's account with its mobile telephony provider (paragraphs 0002 - 0004, 0007 and 0009). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the account to be debited in Stadelmann to be the mobile phone user's mobile telephony account, as is taught to be old and well-known by Teicher.

27. **Regarding claim 6**, Stadelmann further discloses automatically sending a confirmation message back to the mobile telephone (column 4, lines 11-14).
28. **Regarding claim 9**, Stadelmann discloses that the customer can receive the requested service directed on the mobile device (column 4, lines 20-27) and that the services may include the Internet, online services or computer programs (column 1, lines 8-22). However, Stadelmann does not explicitly disclose that service may be a game or competition to be played on the receiver. Teicher, in an analogous art, teaches that it was old and well-known in the art at the time the invention was made that goods sold via electronic or mobile commerce may include digital content, such as games (paragraphs 0002-0004).
29. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stadelmann in view of Teicher, and further in view of Thakker (US Patent No. 6,487,602).
30. **Regarding claim 10**, the combination of Stadelmann and Teicher teaches the limitations of claim 8, as discussed above. However, Stadelmann does not explicitly disclose that the coded text message is sent by a mobile telephone to an Internet web site. Thakker, in an analogous art, teaches a system and method for accessing the internet in an internet-protocol based cellular network (see Abstract) which allows a user of mobile phone to send a text message to a website, in order to retrieve information

and utilize service offered on the website (column 2, lines 2-33) without the need for a computer or ISP (column 1, lines 60-67). Therefore, it would have been obvious to one of ordinary skill in the art to modify Stadelmann to transmit text messages to websites to access the service and information offered thereon, as taught by Thakker, in order to expand the services available through a mobile phone.

31. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stadelmann in view of Teicher, and further in view of Official Notice.

32. **Regarding claim 11,** the combination of Stadelmann and Teicher teaches the limitations of claim 8, as discussed above. Stadelmann, as noted above, discloses debiting the cost of the goods or services to an account. However, Stadelmann does not explicitly disclose debiting the cost of the goods and the text message using a premium rate text message destination. The Examiner takes Official Notice that it was old and well-known in the art at the time the invention was made to bill an account for the use of premium rate services, such as voting in a poll via SMS or real-time gaming, for the purpose of streamlining the billing of the customer and payment to the service provider. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Stadelmann to bill the user for use of premium rate services, in order to streamline billing for such services, as is old and well-known.

33. **Regarding claim 12,** the combination of Stadelmann and Teicher teaches the limitations of claim 8, as discussed above. Stadelmann, as noted above, discloses debiting the cost of the goods or services to an account. However, Stadelmann does not explicitly disclose the use of pre-paid and post-paid accounts. Examiner takes Official Notice that it was old and well-known in the art at the time the invention was made to offer pre-paid or post-paid accounts to mobile phone users for the purpose of providing users with multiple options to comport with the creditworthiness and personal usage and billing preferences of the individual users. Therefore, it would have been obvious to one of ordinary skill in the art that the account to be debited in Stadelmann may be either a pre-paid account or a post-paid account, depending on the particular type of account of the user making the transaction.

Conclusion

34. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Cramer (US Patent Application Publication No. 2006/0020540) discloses a method and apparatus for performing electronic transactions using a mobile phone.
- Lagadec, et al. (US Patent Application Publication No. 2004/0098625) discloses a method for transmitting an anonymous request from a consumer to a content or service provider through a telecommunication network including coded messages.
- Burgess, et al. (US Patent Application Publication No. 2004/0014454) discloses a wireless data system including transmitting codes.

- Fisher, et al. (US Patent Application Publication No. 2003/0119447) discloses interactive advertising using a mobile telephone.
- Bisdikian, et al. (US Patent Application Publication No. 2004/0117857) discloses a system and a method for personalised, transaction-oriented, interactivity over non-interactive (one way) broadcast networks.
- Rochet (US Patent Application Publication No. 2004/0204952) discloses a system and a method for performing personalised interactive automated electronic marketing of the marketing service provider including product codes.
- Hurst, et al. (US Patent Application Publication No. 2004/0198308) discloses a method and apparatus for the superdistribution of content in a network including stationary and mobile stations.
- Kwan (US Patent Application Publication No. 2002/0147658) discloses a computer network method for conducting payment over a network by debiting and crediting telecommunication accounts.
- Kang, et al. (Korean Publication No. KR 2002071429 A) discloses a method and system for offering electronic commerce service over wireless communication network including the transmission of codes.
- Roberts (US Patent Application Publication No. 2003/0152039) discloses customer billing in a communications network.
- Corrigan, et al. (US Patent Application Publication No. 2002/0187775) discloses a WAP service personalisation, management and billing object oriented platform including pre-paid and post-paid accounts.

- Bartter, et al. (US Patent Application Publication No. 2004/0088244) discloses a system and method for accommodating rated transactions in an electronic commerce system.
- Back, et al. (US Patent Application Publication No. 2003/0036396) discloses a method for receiving data using SMS and wireless internet and system thereof.
- Mamdani, et al. (US Patent No. 6,925,307) discloses a mmixed-mode interaction including mobile commerce using a SMS.
- Olah (US Patent Application Publication No. 2003/0050042) discloses a method for billing short messages in a mobile radio network.

35. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bradley Wright whose telephone number is (571)272-5872. The examiner can normally be reached on M - F 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/jbw/

/James P Trammell/
Supervisory Patent Examiner, Art Unit 3694